

THE OFFICE ACTION

In the office action mailed April 19, 2007, the Examiner objected to claims 1-3, 5-10, 12, 15, 16, 18 and 19 for various informalities. The Examiner rejected claims 14, 19, 20, 23 and 24 under 35 U.S.C. §112, 2nd paragraph for being indefinite. The Examiner rejected claims 1-3, 6-10, 12, 15, 16, 18-20, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Funakubo. The Examiner rejected claims 1-3, 6-9, 13-16, 18-20, 23 and 24 under §103(a) as being unpatentable over Raetz in view of Funakubo. The Examiner rejected claim 5 under §103(a) as being unpatentable over Wright in view of Funakubo or Raetz in view of Funakubo and further in view of Ackley or Abbot, or Oehrli, or Ehlen, or Carlton. The Examiner rejected claim 10 under §103(a) as being unpatentable over Wright in view of Funakubo or Raetz in view of Funakubo and further in view of Dawson or Gaddis.

REMARKS

The pending claims in the application are claims 1-3, 5-27, and 29-30. Claims 11, 17, 21, 22, 25-27, 29, and 30 have been withdrawn from consideration.

A. Claim Objection

In the December 12, 2006 office action, the Examiner objected to claims 1-3, 5-10, 12, 15, 16, 18 and 19 for various informalities. Amendments have been made to claims 1, 7, 15, 16, 18, 19 and 27 to address these objections. Withdrawal is therefore respectfully requested.

B. The §112 Rejections

Claims 14, 16, 18, and 19 have been amended to address these rejections. Withdrawal is respectfully requested.

C. The §103 Claim Rejection based on Wright in view of Funakubo

1-3, 6-10, 12, 15, 16, 18-20, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over Wright in view of Funakubo. Applicants respectfully traverse.

The Examiner states that “Wright discloses a link of a saw chain with almost every structural limitation of the claimed invention.” Applicants respectfully submit that Wright fails to disclose many features of the claimed invention. That is, with reference to claims 1, 18 and 19, Wright fails to disclose or suggest a base member adapted to be pivotally connected to other links of the saw chain. In this respect, the Examiner attempts to equate the clevis (52) of Wright as a base member. However, if this is so, the clevis of Wright clearly is NOT adapted to be “pivotally connected to other links”. Rather, the clevis of Wright is pivotally connected to shoulders (47) of the sawplate (42) by a pin (56). In fact, because Wright does not disclose a saw chain, but rather a circular saw, there is only a single sawplate. Thus, there are not even any “other links” that the clevis can be connected to.

Further, and with regard to claim 16, Wright fails to disclose or suggest a cutting member for a saw chain for cutting wood comprising a cutting edge and an interior recess having surface having a taper. Rather, as clearly seen in Wright, it discloses a tooth assembly (50) with an exposed shank (66) having a taper, rather than an internal recess with a taper. That is, Wright discloses a male type tooth assembly that fits inside a clevis, while the present invention is directed to a female type tooth assembly that accepts a seat surface of the base member in a recess.

The combination of Funakubo with Wright fails to cure the deficiencies found in Wright with respect to the claims. That is, the Examiner cites Funakubo for teaching the use of sintered and compacted particles of abrasion resistant material. Even assuming that Funakubo discloses the use of such materials in cutting members and even assuming the propriety of combining Funakubo with Wright, such a combination still does not disclose or suggest the claimed inventions including a a base member adapted to be pivotally connected to other links of a saw chain or a cutting member with an internal tapered recess. Thus, withdrawal of this rejection is requested.

D. The §103 Rejection Based on Raetz in View of Funakubo

The Examiner rejected claims 1-3, 6-9, 13-16, 18-20, 23 and 24 under §103(a) as being unpatentable over Raetz in view of Funakubo. Applicants respectfully traverse.

First, Raetz discloses a device wherein the cutting sleeve has an internal passage 14 with cross section in the longitudinal direction that is rectangular. (col. 3, lines 1-3). As amended, present claim 16 now recites that the cutting member has an interior recess with a tapered surface. This tapered surface thus would result in a cross-section of the interior recess having a trapezoid shape. Raetz does not disclose a tapered surface in the interior passage of its cutting sleeve.

Second, and with respect to all of the claims, such a proposed combination does not disclose or suggest wherein the first and second taper have a close tolerance comprising no more than 0.5°. As detailed in the present application, one manner in which this close tolerance can be achieved is by forming the cutting member from sintered and compacted particles of abrasion resistant material. Although other methods of achieving such close tolerances are known, Raetz provides absolutely no suggestion or disclosure of such tight tolerances or how they may even be achieved.

In addition, in support of this rejection, the Examiner stated that the use of such materials on cutting teeth is old and well known in the art. The Examiner cites Funakubo as disclosing the use of sintered and compacted particles of abrasion resistant material on cutting teeth. In response, Applicants submit that at best, Funakubo only suggests or motivates the person of ordinary skill in the art to modify the teachings of Raetz to use such materials as the cutting tip of the cutting element of Raetz and that Funakubo provides no motivation for using such materials as an internal mating surface.

The Examiner responded to this argument as articulated in the previous response by stating that “Funakubo teaches making the entire unitary cutter or cutting tip from the recited material. This would teach one having ordinary skill in the art to make the entire unitary cutter of...Raetz from the recited material.” Applicants respectfully disagree. As clearly seen in Funakubo, this reference teaches a bimetallic cutting tool including a plurality of teeth with each forward top end **ONLY** having a brazed or welded on tip made from such materials. The entire tooth is **NOT** made from the material.

As the Examiner will appreciate, in determining the question of obviousness, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983). In this respect, prior art references must be

considered in their entirety, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1985).

Here, Funakubo clearly teaches only the tip of the cutting tooth as being made from such material. Thus, any proposed combination of Funakubo with Raetz or Wright would lead one skilled in the art to only replace the tips of such cutting teeth of Raetz or Wright with the materials of Funakubo, NOT the entire cutting body.

Further, and with regard to claims 15 and 18, even assuming that the proposed combination of Raetz and Funakubo teaches the use of sintered and compacted particles of abrasion resistant material as the cutting element, such a combination does not teach or suggest constructing any part of the *base member* using these materials. Withdrawal of this rejection is requested.

E. The §103 Rejections Based on Wright or Raetz in View of Funakubo and Other Cited References

The Examiner rejected claims claim 5 as being unpatentable over Wright in view of Funakubo or Raetz in view of Funakubo and further in view of Ackley or Abbot, or Oehrli, or Ehlen, or Carlton and claim 10 as being unpatentable over Wright in view of Funakubo or Raetz in view of Funakubo and further in view of Dawson or Gaddis.

Applicants respectfully traverse based on arguments presented above. That is, the Examiner cites these additional references as allegedly teaching constructing the base member of stamped metal and wherein the abrasion resistant material comprises a tool steel alloy. Even assuming for purposes of argument that these references teach such elements and even assuming the propriety of combining such references, the combination still does not teach or disclose all of the elements of the base claims on which claims 5 and 10 depend. That is, none of Ackley, Abbot, Oehrli, Ehlen, Carlton, Dawson or Gaddis cure the deficiencies in the proposed combinations of Wright or Raetz in view of Funakubo. Thus, withdrawal of these rejections are requested.

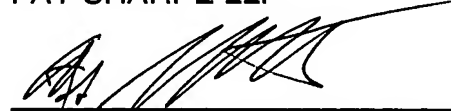
CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-3, 5-10, 12-16, 18-20, 23, and 24) are now in condition for allowance.

Respectfully submitted,

FAY SHARPE LLP

7/19/07
Date



Scott A. McCollister, Reg. No. 33,961
1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2579
216-861-5582

L:\JEW\DATA\INDI\200002\amendment.doc